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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,542	08/29/2001	Noman F. Kane	60158-143	7036

26096 7590 06/18/2004
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EXAMINER

NGUYEN, THUKHANH T

ART UNIT PAPER NUMBER

1722

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/941,542	Applicant(s) KANE, NOMAN F.	
	Examiner Thu Khanh T. Nguyen	Art Unit 1722	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachedment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,3-14,25 and 26.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

ADVISORY ACTION

1. Applicant's requests for consideration filed May 25, 2004 have been fully considered but they are not persuasive.

The Applicant has argued that the English abstract of the German reference was insufficient to understand the reference. Thus, the claims are not rejectable over the German reference. The Applicant has cited *Ex parte Gavin*, 62 USPQ2d 1680, saying that the Examiner must provide an English language translation of the entire patent or remove it as a reference.

The examiner respectfully disagree with this allege, because there are substantial differences between *Gavin* and the current case. In *Gavin* the examiner there had used English abstracts of Japanese references to reject a composition claim, in which the English abstracts do not expressly describe the composition. The Board held that those abstracts do not provide enough information to permit an inference that the claimed composition was an inherent.

In the current case, however, the English abstract includes descriptions of the tube bending tool and a plurality of drawings have provided in the German reference, which enable one of ordinary skill in the art to understand the structures and the cooperation of the German bending tool. Unlike *Gavin*, in which the composition could only be understood from the description of the reference, the English's abstract including descriptions of the drawing and the drawings provided in the reference have given a very good understanding of the German reference. Therefore, the rejections over the German reference are still deems appropriate.

No place in *Gavin* had the Board said that the Examiner must provide an English language translation of the entire patent or remove it as a reference, as cited by the Applicant.

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However, the Board have said that “[i]t is our opinion that a proper examination under 37 CFR §1.104 should be based on the underlying documents and translations, **where needed.**” (page 1684, emphasis added). Thus, in the case that an English translation is not needed, the examiner doesn’t have to remove a reference as prior art.

In regard to the admitted prior art, the Applicant have asserted that the admitted prior art did not refer to any flanges, but to the mold as a whole, and that the flange portion does not curve away from the channel as claimed by the applicant. The examiner respectfully disagrees because even the description does not refer to the flange of the mold, the drawing (Fig. 2) clearly indicates that there is a flange portion on top of the molding channel (18) and curves away at a 90° angle.

2. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

3. A request for translation of the German reference has been submitted. A copy of an English equivalent will be provided to the Applicant as soon as it becomes available.


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Khanh T. Nguyen whose telephone number is 571-272-1136. The examiner can normally be reached on Monday- Friday, 6:30-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TN



ROBERT DAVIS
PRIMARY EXAMINER
GROUP 1300

6/16/2004